REMARKS

Claims 1, 3, 5, and 7 are pending and under consideration. Claims 1, 3, and 5 are amended herein. Claims 2, 4, and 6 are canceled herein without prejudice or disclaimer. Support for the amendments to claims 1, 3, and 5 may be found in claims 2, 4, and 6 as filed originally. Further reconsideration is requested based on the foregoing amendments and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive.

<u>Section 8 at page 5:</u>

The final Office Action asserts in section 8, at page 5 that:

Regarding the argument that the disclosure in Anderson et al. is not in as complete detail as is contained in the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

Even in *Graves*, however, in contrast to the claimed invention, the cited element, i.e. simultaneous monitoring of the output points, was to be *found* in the cited reference. The issue in *Graves*, rather, was only whether a skilled artisan would know about series monitoring, as in Rockwell, as well as the parallel monitoring of the claim at issue (*Graves* at 1701). U.S. Patent No. 5,581,682 to Anderson et al., (hereinafter "Anderson"), in contrast, does not show all of the claimed elements in the *first* place, let alone show them to the extent that a skilled artisan could take its teachings *in combination with his own knowledge of* the particular art and be in possession of the invention.

<u>Section 9 at page 6:</u>

The final Office Action asserts in section 9, at page 6 that:

To the extent that applicant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but **need not be in the identical words** as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Applicants agree that, in order to anticipate the claims, Anderson would need to show the claimed elements arranged in the same order as they are recited in the claims. The Applicants, moreover, are not arguing simply that Anderson fails to use the same *names* for certain elements as the names used by Applicants. The Applicants, rather, are arguing that Anderson does not show all of the claimed elements in the first place, let alone all of the claimed elements arranged in the same order as they are recited in the claims.

Under the provisions of M.P.E.P. § 2131, furthermore, a reference must teach every element of a claim in order to anticipate a claim. As provided therein:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since each and every element as set forth in either claim 3, claim 5, or claim 7 are not to be found in Anderson, Anderson cannot anticipate claims 3, 5, or 7, *Verdegaal Bros. v. Union Oil Co. of California*.

M.P.E.P. § 2131 also requires the identical invention to be shown in as complete detail as is contained in the claim. As provided therein:

> "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Since neither claim 3, claim 5, nor claim 7 is shown in Anderson in as complete detail as is contained in the claims, Anderson cannot anticipate claims 3, 5, or 7, *Richardson v. Suzuki Motor Co.*

Finally, M.P.E.P. § 2131 requires the elements to be arranged as required by the claim. As provided therein:

> The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Since Anderson does not show the elements of either claim 3, claim 5, or claim 7 arranged as required by the claim, Anderson cannot anticipate claims 3, 5, or 7, *In re Bond*.

M.P.E.P. § 2143.03, similarly, requires all the claim limitations to be taught or suggested by the prior art. As provided therein:

> To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Since all of the limitations of claim 1 are not taught or suggested by Anderson, a prima facie case of obviousness of claim 1 has not been established, *In re Royka.*

<u>Section 10 at page 6:</u>

The final Office Action asserts in section 11, at page 6 that:

Regarding the argument that Anderson et al. fail to disclose an auxiliary storage unit storing a dictionary which contains the at least one character string of non-disclosure in association with at least one corresponding reason, Anderson et al. indeed disclose an auxiliary storage unit storing a dictionary which contains the at least one character string of non-disclosure in association with at least one corresponding reason. See, for example, the abstract and claims 1-5.

This is submitted to be without basis. The Abstract of Anderson mentions no dictionary at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited formerly in, for example, claims 3 and 5. There are only two sentences in the Abstract of Anderson. The first sentence of the Abstract of Anderson, in particular, describes only:

This invention is a method for annotating and redacting a final-form document archived in a computerized system where it is important that the fidelity of the final form document is preserved.

As may be seen from the first sentence of the Abstract of Anderson, no dictionary is mentioned at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited formerly in, for example, claims 3 and 5.

The second sentence of the Abstract of Anderson, similarly, describes only:

More particularly, this method allows final-form documents containing objects such as texts, graphics and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

As may be seen from the second sentence of the Abstract of Anderson, no dictionary is mentioned at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited formerly in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," either.

Nevertheless, in the interest of compact prosecution only, and not for any reason of patentability, the second clause of claim 3 has been amended to recite:

> An auxiliary storage unit for storing a non-disclosure dictionary which registers a character string of non-disclosure associated with its corresponding reason and a compulsory disclosure dictionary which registers a character string of compulsory disclosure associated with its corresponding reason.

Andersen neither teaches, discloses, nor suggests "an auxiliary storage unit for storing a non-disclosure dictionary which registers a character string of non-disclosure associated with its corresponding reason and a compulsory disclosure dictionary which registers a character string of compulsory disclosure associated with its corresponding reason," as now recited in claim 3.

The second clause of claim 5, similarly, has been amended to recite:

> Retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason.

Anderson neither teaches, discloses, nor suggests "retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as now recited in claim 5.

Section 11 at page 6:

The final Office Action asserts in section 12, at pages 6 and 7 that:

> Regarding the argument that Anderson et al. fail to disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document, Anderson et al. indeed disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document. See, for example, the abstract and claims 1-5.

This is submitted to be without basis. The Abstract of Anderson does not mention "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," as recited formerly in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," either.

Nevertheless, in the interest of compact prosecution only, and not for any reason of patentability, the fourth clause of claim 3 has been amended to recite:

> Embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document.

Andersen neither teaches, discloses, nor suggests "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as now recited in claim 3.

The fourth clause of claim 5, similarly, has been amended to recite:

Embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document.

Anderson neither teaches, discloses, nor suggests "embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as now recited in claim 5.

Section 12 at pages 6 and 7:

The final Office Action asserts in section 13, at page 7 that:

Regarding the argument that Anderson et al. fail to disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed, Anderson et al. indeed disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed. See, for example, the abstract and claims 1-5.

This is submitted to be without basis. The Abstract of Anderson does not mention "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," as recited formerly in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," either.

Nevertheless, in the interest of compact prosecution only, and not for any reason of patentability, the fifth clause of claim 3 has been amended to recite:

Replacing the retrieved tag of non-disclosure is given to a meaningless character string, when the original document is accessed.

Andersen neither teaches, discloses, nor suggests "replacing the retrieved tag of non-disclosure is given to a meaningless character string, when the original document is accessed," as now recited in claim 3.

The fifth clause of claim 5, similarly, has been amended to recite:

Replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed," as now recited in claim 5. Further reconsideration is thus requested.

Rejection under 35 U.S.C. § 102:

Claims 3, 5, and 7 were rejected under 35 U.S.C. § 102(b) as anticipated by Anderson. The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration of the rejection is earnestly solicited.

The second clause of claim 3 recites:

Storing a non-disclosure dictionary which registers a character string of non-disclosure associated with its corresponding reason and a compulsory disclosure dictionary which registers a character string of compulsory disclosure associated with its corresponding reason.

Anderson neither teaches, discloses, nor suggests "storing a non-disclosure dictionary which registers a character string of non-disclosure associated with its corresponding reason and a compulsory disclosure dictionary which registers a character string of compulsory disclosure associated with its corresponding reason," as recited in claim 3. Anderson, rather, mentions no dictionary at all.

The fourth clause of claim 3 recites:

Embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document.

Anderson neither teaches, discloses, nor suggests "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as recited in claim 3, either. In Anderson, rather, final-form documents are annotated or redacted *without* compromising the integrity of the original document. In particular, as described in the Abstract:

More particularly, this method allows final-form documents containing objects such as texts, graphics and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

Since Anderson wants to annotate or redact final-form documents without compromising the integrity of the original document, Anderson is not "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document " as recited in claim 3.

Anderson, furthermore, *maintains* the document's integrity. In particular, as described at column 2, lines 20-24:

> The present invention embodies a method to store and retrieve final form documents which not only maintains the document's integrity but also overcomes the difficulties and inconvenience encountered in using an editor or merging and overlaying two files using links to an external file.

Since Anderson maintains the document's integrity, Anderson is not "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document " as recited in claim 3.

Furthermore, in Anderson, the contents of the original, underlying document as archived is *not* changed. In particular, as described at column 2, lines 42-47:

> With both annotation and redaction, the contents of the original, underlying document as archived is not changed. However, a reviewer may see either the original document or the document with the annotations or redacted sections included.

Since, in Anderson, the contents of the original, underlying document as archived is not changed, Anderson is not "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document " as recited in claim 3.

Anderson, furthermore, only wants to allow annotation of final form objects *without* changing the contents. In particular, as described at column 2, lines 65, 66, and 67:

> This invention uses the overlay function but has added a "conditional processing" structure to allow annotation of final form objects without changing the contents.

Since Anderson only wants to allow annotation of final form objects without changing the contents, Anderson is not "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document " as recited in claim 3.

Finally, Anderson, uses a forms *overlay* structure to store the data. In particular, as described at column 5, lines 44 and 45:

> The method of the invention uses the forms overlay structures in order to store the data.

Since Anderson uses a forms overlay structures to store the data, Anderson is not "embedding the tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document " as recited in claim 3.

The fifth clause of claim 3 recites:

Replacing the retrieved tag of non-disclosure is given to a meaningless character string, when the original document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the retrieved tag of non-disclosure is given to a meaningless character string, when the original document is accessed," as recited in claim 3, either. Anderson, rather, positions *overlays* on the page based on *coordinate* data contained in the overlay reference. In particular, as described at column 3, lines 47-55:

With the current final form overlays, each annotation is stored as a separate data object in a library which is referenced from within the final form documents. When the final form document is presented, the referenced object is retrieved and merged with the specific data page. Overlays are then positioned on the page based on coordinate data contained in the overlay reference.

Since Anderson positions overlays on the page based on coordinate data contained in the overlay reference, Anderson is not "replacing the retrieved tag of non-disclosure is given to a meaningless character string, when the original document is accessed " as recited in claim 3. Claim 3 is thus submitted to be allowable. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claim 5:

The second clause of claim 5 recites:

Retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason.

Anderson neither teaches, discloses, nor suggests "retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as discussed above with respect to the rejection of claim 3.

The fourth clause of claim 5 recites:

Embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document.

Anderson neither teaches, discloses, nor suggests "embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as discussed above with respect to the rejection of claim 3.

The fifth clause of claim 5 recites:

Replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed," as discussed above with respect to the rejection of claim 3. Claim 5 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 3. Withdrawal of the rejection of claim 5 is earnestly solicited.

Claim 7:

Claim 7 recites:

Replacing the character string of non-disclosure with a meaningless character string according to said reason, when there is said character string of non-disclosure in said dictionary.

Anderson neither teaches, discloses, nor suggests "replacing the character string of non-disclosure with a meaningless character string according to said reason, when there is said character string of non-disclosure in said dictionary," as discussed above with respect to the rejections of claims 3 and 5. Claim 7 is thus submitted to be allowable for at least those reasons discussed above with respect to the rejections of claims 3 and 5. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson. The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration of the rejection is earnestly solicited.

The second clause of claim 1 recites:

Retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason.

Anderson neither teaches, discloses, nor suggests "retrieving at least one character string of non-disclosure in an original document by referring to a non-disclosure dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as discussed above with respect to the rejections of claims 3 and 5. Anderson, rather, mentions no dictionary at all.

The fourth clause of claim 1 recites:

> Embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document.

Anderson neither teaches, discloses, nor suggests "embedding a tag and the reason of non-disclosure corresponding to the retrieved character string which registered in said non-disclosure dictionary in said XML formatted document," as recited in claim 1. Anderson, rather, mentions no "tag of non-disclosure," "reason of non-disclosure corresponding to the character string," or "XML formatted document" at all. The final Office Action notes in section 6, at page 4 that "the document of Anderson et al. is not disclosed as being formatted in XML," and asserts that:

> However, XML formatting is a well-known, hence obvious, markup language to use in formatting an electronic document, and of visual notice to that effect is hereby taken.

The Applicant respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. The Applicant specifically points out the following errors in the Examiner's action.

First, the Examiner uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

> any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. *See* M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the Examiner's assertion. *See* M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the Examiner also bases the rejection, at least in part, on personal knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an

assertion with an affidavit when called for by the Applicant. Thus, Applicant calls upon the Examiner to support such assertion with an affidavit.

The fifth clause of claim 1 recites:

Replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the original document is accessed," as discussed above with respect to the rejections of claims 3 and 5, either. Claim 1 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejections of claims 3 and 5. Withdrawal of the rejection of claim 1 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3, 5, and 7 are allowable over the cited references. Allowance of claims 1, 3, 5, and 7, as well as this entire application, is earnestly solicited. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.
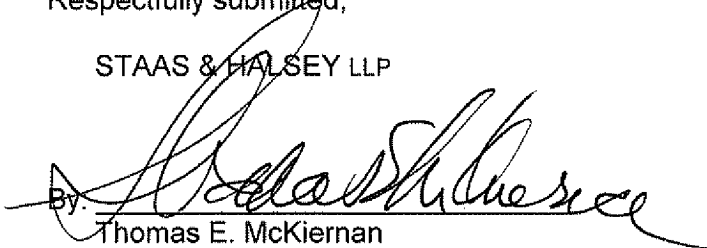
Respectfully submitted,

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